

The opinion in support of the decision being entered
today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH KY TRIEU HO

Appeal No. 2007-2171
Application No. 09/821,066
Technology Center 3600

Decided: September 25, 2007

Before TERRY J. OWENS, HUBERT C. LORIN, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from a decision of the Examiner rejecting claims
1-16. 35 U.S.C. § 134 (2002). We have jurisdiction under 35 U.S.C. § 6(b)
(2002).

The invention is directed to a computer system for processing product price requests and placing products orders over the internet. (Specification 1:1-3).

Claims 1-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Scheer (US Patent Application Publication 2002/0143669 A1).

We AFFIRM.¹

Claims 1, 3, 6, and 13 are the independent claims.

1. A method of grouping parts in inventory, comprising:
defining a database for indicating functional relationships between a plurality of parts; and
searching the database to identify one or more groups of functionally interchangeable parts.
3. A method of generating a list of interchangeable parts, comprising:
defining a first table identifying a plurality of parts;
defining a second table, associated with the first table, indicating functional relationships between the parts; and
recursively searching the first and second tables to generate the list of interchangeable parts.
6. A parts inventory system, comprising:
a database for indicating functional relationships between a plurality of parts; and
a search engine for searching the database to identify one or more groups of functionally interchangeable parts.

¹ Our decision will make reference to Appellant's Appeal Brief ("Appeal Br.," filed Dec. 9, 2005), the Examiner's Answer ("Answer," mailed Feb. 15, 2006), and to the Reply Brief ("Reply Br.," filed Mar. 28, 2006).

13. A computer program product in a computer-usable medium, comprising:
 means for defining a database for indicating functional relationships between a plurality of parts; and
 means for searching the database to identify one or more groups of functionally interchangeable parts.

A. Issue

The issue is whether Appellant has shown that the Examiner erred in holding Scheer anticipates the claimed subject matter.

B. Findings of Fact

The record supports the following findings of fact (FF) by a preponderance of the evidence.

1. In the Final Rejection (mailed Aug. 5, 2005; p. 2; reproduced in the Answer 5-6), The Examiner found that Scheer described the subject matter of claim 1, stating the follows:

Referring to claim 1.-Scheer discloses a method of grouping parts in inventory (abstract), comprising:

- Defining a database (Figure 8, "Record Parameters in the Product Master Data Base") for indicating functional relationships between a plurality of parts (paragraph 0147 and paragraph 0171); and
- Searching the database (Figure 8, "Record Parameters in the Product Master Data Base") to identify one or more groups of functionally interchangeable parts (paragraph 0147 and paragraph 0171).

2. In the Final Rejection (p. 4; reproduced in the Answer 6), the Examiner found that Scheer described the subject matter of claim 3, stating the following:

Referring to claim 3-4.-Scheer discloses a method of generating a list of interchangeable parts, comprising:

- Defining a first table identifying a plurality of parts (Figure 7 and paragraph 0174); Defining a second table, associated with the first table, indicating functional relationships between the parts (Figure 7 and paragraph 0174);
- Recursively searching the first and second tables to generate the list of interchangeable parts (Figure 7 and paragraph 0174); and
- Receiving a part identifier (paragraph 0233).

3. In the Final Rejection (p. 4; reproduced in the Answer 6), the Examiner found that Scheer described the subject matter of claim 6, stating the following: “Referring to claims 6-9. Claims 6-9 are rejected under the same rationale as set forth above in claims 1-5.” (Answer 6).

4. In the Final Rejection (p. 4; reproduced in the Answer 6), the Examiner found that Scheer described the subject matter of claims 13, stating the following: “Referring to claims 13-14. Claims 13-14 are rejected under the same rationale as set forth above in claims 1-5.” (Answer 7).

5. The Appeal Brief argues the following Appellants in rebuttal:

The rejection under §102(e) as anticipated by Scheer is traversed. In order to maintain this anticipation rejection, each and every claim element must be disclosed by the reference in as great detail as claimed. Scheer fails to disclose at least “defining a database for indicating functional relationships between a plurality of parts; and searching the database to identify one or more groups of functionally interchangeable parts” as claimed in claims 1, 6, and 13. At most, Scheer discloses that an agent may determine if a distributor has access to any equivalent products. See, Scheer, para. 0147. Scheer does not disclose the existence of *any database for indicating functional relationships between a plurality of parts*. Therefore, Scheer cannot anticipate claims 1, 6 or 13.

Furthermore, since Scheer does not disclose a database indicating functional relationships between a plurality of parts, Scheer

likewise cannot disclose searching the database, as further claimed in claims 1, 6, and 13.

Additionally, Scheer does not disclose “defining a first table identifying a plurality of parts; defining a second table, associated with the first table, indicating functional relationships between the parts; and recursively searching the first and second tables to generate [a] list of interchangeable parts” as claimed in claim 3. Claims 4 and 5 depend directly or indirectly from claim 3 and are therefore allowable over Scheer for at least the same reasons.

Claims 2, 7-12, 14 and 16 depend directly or indirectly from claims 1, 6, and 13 and are therefore allowable over Scheer for at least the same reasons.

(Appeal Br. 9).

6. This rebuttal argument was originally presented in Appellant’s response (filed January 23, 2004) to the Office action mailed October 23, 2002.

7. The Final Rejection (pp. 4-5; reproduced in the Answer at p. 7) responded to this rebuttal argument as follows:

Applicant's arguments filed January 27, 2004 have been fully considered but they are not persuasive.

The Attorney argues that Sheer [sic] does not disclose at least defining a database for indicating functional relationships between a plurality of parts; and searching the database to identify one or more groups of functionally interchangeable parts.

The Examiner notes, Sheer [sic] does disclose an intelligent order fulfillment planning process, wherein for each order the distributor has access to data relating to equivalent products. An equivalent product can be a product that has the same functions and features as a specified product. The equivalency of functions and features is determined as a function of product definitions provided by the distributor. This action of substitution utilizes the Intelligent Agent as shown in Figure 2. Also shown in Figure 2 is a linkage between the Intelligent Agent and the distributor whereby the Intelligent Agent can locate the product definitions. The product definitions is how the Agent Identifies groups of functionally interchangeable parts,

whereby these definitions are stored on the Distributor Collaboratory Server.

The Attorney argues that Sheer [sic] does not disclose defining a first table identifying a plurality of parts, defining a second table, associated with the first table, indicating functional relationships between the parts, and recursively searching the first and second tables to generate a list of interchangeable parts.

The Examiner notes, Sheer [sic] does disclose a system that is implemented using a high degree of table-driven and parameter driven software engineering techniques (Sheer [sic]: paragraph 0174).

8. The Appeal Brief does not address this response set forth in the Final Rejection and therefore does not traverse the findings set forth therein.
9. The Appeal Brief does not address the disclosure in paragraph 0171 and Fig. 8 of Scheer that the Examiner relied upon to show that the subject matters of claims 1, 6, and 13 are described in Scheer.
10. Fig. 8 of Scheer explicitly describes a "Data Base."
11. The Appeal Brief does not address the disclosure in paragraphs 0174 and 0233 and Fig. 7 of Scheer that the Examiner relied upon to show that the subject matter of claim 3 is described in Scheer.
12. Paragraph 0174 of Scheer explicitly describes inventory managing processes "using a high degree of table-driven and parameter driven software engineering techniques."
13. The Examiner responded to the arguments made in the Brief by arguing essentially the points made in the Final Rejection is response to the rebuttal argument presented in Appellant's response to the Office action mailed October 23. (See above at FF 7.)(Answer 7.)
14. The Reply Brief responded as follows:

The Examiner has failed to prove a case of anticipation under §102(e). Despite all the Examiner's allegations, the Examiner's burden

to prove anticipation is clear - each and every element of the claim must be disclosed by the reference in as great detail as claimed.

Claim 1 requires defining a database for indicating functional relationships between a plurality of parts; and searching the database to identify one or more groups of functionally interchangeable parts. Each of the Examiner's attempts to show either element fails, as Scheer never discloses any such database, and does not disclose any such detail in as great detail as claimed.

The Examiner cites to paragraphs 147 and 171:

....

The Examiner has not proven his alleged anticipation. At most, Scheer discloses determining if the distributor has access to any equivalent products (¶147), but *does not say how*. Scheer discloses that a customer can be provided with an option to take a substitute (¶171) but does not disclose how to determine what products are substitutes.

It is quite well settled that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See, MPEP § 2131. Without disclosing a database for indicating functional relationships between a plurality of parts; and searching the database to identify one or more groups of functionally interchangeable parts, Scheer cannot anticipate these claims.

(Reply Br. 2-3).

15. The Appeal Brief does not address the disclosure at Fig. 8 of Scheer that the Examiner relied upon to show that the subject matters of claims 1, 6, and 13 are described in Scheer.

C. Principles of Law

1. Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).
2. It is well settled that in order for the examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431; *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

D. Analysis

The issue is whether the Examiner erred in rejecting the claims under 35 U.S.C. § 102 on the ground that Scheer anticipates the claimed subject matter.

We have carefully reviewed the Appeal Brief and Reply Brief and find that Appellant has not met his burden of showing that the Examiner has failed to make a *prima facie* case of anticipation.

The Examiner made an element-by-element analysis of the claims showing where in Scheer each element of the claims is described. Appellant's response has been to selectively address, and in isolation, a portion of the Examiner's position and to leap to the conclusion that the Examiner has failed to show that Scheer anticipates the claimed subject matter.

For example, with respect to claims 1, 6, and 13, the Examiner has clearly stated that Fig. 8 of Scheer describes a database. That is evident to

anyone reading the reference. The Examiner relied on Fig. 8 as the principal support for showing that Scheer describes defining a database and searching the database. Appellant has never addressed Fig. 8 or the Examiner's reliance thereon. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004). Accordingly, we find that Scheer at Fig. 8 describes defining a database and searching the database.

The question then becomes whether, in light of Fig. 8, Scheer anticipates defining the database for indicating functional relationships between a plurality of parts and searching the database to identify one or more groups of functionally interchangeable parts. In that regard, the Examiner not only relied on paragraphs 0147 and 0171 but also stated that

Sheer does disclose an intelligent order fulfillment planning process, wherein for each order the distributor has access to data relating to equivalent products. An equivalent product can be a product that has the same functions and features as a specified product. The equivalency of functions and features is determined as a function of product definitions provided by the distributor. This action of substitution utilizes the Intelligent Agent as shown in Figure 2. Also shown in Figure 2 is a linkage between the Intelligent Agent and the distributor whereby the Intelligent Agent can locate the product definitions. The product definitions is how the Agent identifies groups of functionally interchangeable parts, whereby these definitions are stored on the Distributor Collaboratory Server. [FF 7.]

This latter discussion was provided in the Final Rejection but Appellant has never responded to it. Accordingly, the Examiner's position that Scheer describes defining functional relationships between a plurality of parts and identifying one or more groups of functionally interchangeable parts has not been traversed.

Similarly, with respect to the subject matter of claim 13, the Examiner relied upon paragraphs 0174 and 0233 and Fig 7 of Scheer to show that Scheer anticipated the subject matter of claim 13 (FF 11). Paragraph 0174 of Scheer, for example, explicitly describes inventory managing processes “using a high degree of table-driven and parameter driven software engineering techniques” (FF 12). The Appeal Brief does not address any of this disclosure but simply argues that Scheer does not disclose “defining a first table identifying a plurality of parts; defining a second table, associated with the first table, indicating functional relationships between the parts; and recursively searching the first and second tables to generate the list of interchangeable parts” as claimed in claim 3 (FF 5). A general allegation that the art does not teach a claim limitation is no more than merely pointing out the claim limitation. In that regard, a statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii).

We decline to accept Appellant’s conclusion that the Examiner has failed to show that Scheer anticipates the claimed subject matter given that much of the Examiner’s case in making the prima facie case of anticipation remains unchallenged. To do so would put us in the position of acting as an advocate for Appellant. *Ernst Haas Studio, Inc. v. Palm Press, Inc.*, 164 F.3d 110, 112, 49 USPQ2d 1377, 1379 (2d Cir. 1999) (“Appellant’s Brief is at best an invitation to the court to scour the record, research any legal theory that comes to mind, and serve generally as an advocate for appellant. We decline the invitation.”)

We find that the Examiner has satisfied his burden of showing that Scheer describes the claimed subject matter and all its limitations. Appellant

- Appeal 2007-2171
Application 09/821,066

for his part has not shown that the Examiner erred in holding Scheer anticipates the claimed subject matter.

DECISION

The decision of the Examiner rejecting claims 1-16 under 35 U.S.C. § 102(e) as being anticipated by Scheer is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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Frank C. Nicholas
CARDINAL LAW GROUP
1603 Orrington Avenue, Suite 2000
Evanston, IL 60201